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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/729,459

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Lewis S. Ostrover

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EXAMINER

RAMAKRISHNAIAH, MELUR

ART UNIT

PAPER NUMBER

2614

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/729,459	<b>Applicant(s)</b> OSTROVER ET AL.	
	<b>Examiner</b> Mejor Ramakrishnaiah	<b>Art Unit</b> 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2007.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-29 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-29 and 31-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7-31-2007 has been entered.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 3, 5-29, 31-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For example independent claim 1 has a limitation such as: said generic messages, each generic message being available to several pf the said plurality of telephones. Applicant does not discloses generic messages. The only place word "generic" appears is on page 10 first paragraph which discloses: the variable content message generated by mediator server 30 can be in the voice of the customer, or a generic voice may be used. This does not read on generic messages. Similar situation exists in independent claims 6 and 16.

Claim 1 further recites (last three sentences): said mediator sending on the respective channels the corresponding commands. There is no disclosure in applicant's specification to support this.

### ***Claim Objections***

4. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

Dependent claim 29 depends upon claim 34 which listed after the dependent claim 29.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 recites the limitation "said generic messages" in line 7. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 1 recites the limitation "said mediator" in line 11. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 3, 5, 6-11, 12, 16-18, 21, 25, 28-29, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paris (US PAT: 6,104,787) in view of Pinter (US PAT: 5,894,506).

Regarding claim 1, Paris discloses a telephone system comprising: a plurality of telephones (reads on telephone network with plurality of telephones) including a first telephone (4, fig. 1) and a second telephone (4, fig. 1), a network (2, fig. 1) selectively providing respective voice channels between the first and second telephones and other telephones, and a mediator server (reads on telephone company exchange providing messages) with the network, the mediator server storing a plurality of messages, the messages, each message being available to several of the plurality of telephones, the mediator server receiving at least one of plurality of commands, each command being associated with one of the messages, and in response to the commands, the mediator sending on the respective channels (col. 6, line 65 – col. 7, line 8).

Regarding claim 6, Paris discloses a telephone system comprising: a plurality of telephones (reads on telephone network with plurality of telephones), each telephone selectively establishing an audio channel to other telephones, and mediator server (reads on telephone company exchange providing stored messages: col. 6, line 65 –

col. 7, line 8) being associated with plurality of telephones including and storing plurality of messages, each message being selectable to more than one telephone of the plurality of telephones (this reads on telephone user capable of sending messages stored at the telephone exchange to plurality of calling telephones), the mediator server receiving a command selecting one of the plurality of messages, the mediator server selecting one of the messages when either use terminates a conversation on a respective telephone, or the user causes the telephone to generate the command (col. 4, line 57 – col. 5, line 52; col. 7 lines 18-30, col. 8 lines 26-37).

Regarding claim 16, Paris discloses a method of conducting a telephone conversation comprising: establishing an audio channel between two telephones as shown in fig. 1, selecting in response to a predetermined event (col. 4, line 57 – col. 5, line 52; col. 7 lines 18-30, col. 8 lines 26-37) a message from a plurality of messages stored on a mediator (reads on telephone company exchange providing stored messages: col. 6, line 65 – col. 7, line 8), the messages unrelated to the telephone, each message being available to any telephone having access to the mediator, and sending the message to at least one of the telephones (col. 6, line 65 – col. 7, line 8).

Paris differs from claims 1, 6, and 16 in that though he discloses storing plurality of messages at a central location such as telephone exchange in order to send messages to the telephone users in response to user entering a command (col. 6, line 65 – col. 7, line 8), he does not specifically teach storing plurality of generic messages for use in his system.

However, Pinter discloses method and apparatus for generating and communicating messages between subscribers to an electronic messaging network which teaches: storing plurality of generic messages for use in his system (fig. 1, col. 3, line 24 – col. 4, line 23).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Paris' system to provide for the following: storing plurality of generic messages (reads on canned messages) for use in his system as this arrangement would facilitate to provision more flexible message transmission using a canned message and adding parameters to convey additional information as taught by Pinter, thus providing an more flexible message transmission arrangement.

Regarding claims 3, 7-11, 17-18, 21, Paris further teaches the following: mediator server generates one of voice, a graphic and an alphanumeric message, mediator server is associated with a memory (for example 214, fig. 2), processing member adapted to receive a message in one format and generate a corresponding message in a different format (col. 5 lines 25-29), the telephone generates commands in response user inputs and the mediator server selects the message in response to the commands (col. 5 lines 29-33; col. 8, line 65 – col. 7, line 9), telephone generates commands in response to incoming call, telephone generates commands in response to actions by the user (col. 7 lines 18-30), the predetermined event is activation of a pushbutton at one of the telephones, a predetermined event is termination of conversation at one of the telephones (col. 5 lines 29-37), receiving a signal in one format from one of the

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telephones and processing the signal to generate a message in a different format (col. 5 lines 25-29).

Regarding claims 28-29, 34, Paris teaches the following: event is the end of conversation (col. 5 lines 29-37), event is a command based on user input to the first telephone (col. 7 lines 18-30), commands correspond to predetermined events (col. 7 lines 18-30).

Paris differs from claims 5, 12, 25 in that it does not specifically teach the following: mediator server generates a message with a blank period, with the blank period being filled in with content designated by the user of the first telephone, mediator server generates a message having a standard portion and a blank period and wherein the mediator server fills in the blank period with variable content, generating a message having a fixed portion and a variable portion.

However, Pinter discloses a method and apparatus for generating and communicating messages between subscribers to electronic messaging network which teaches the following: mediator server (reads on 12, fig. 1) generates a message with a blank period, with the blank period being filled in with content designated by the user of the first telephone, mediator server generates a message having a standard portion and a blank period and wherein the mediator server fills in the blank period with variable content, generating a message having a fixed portion and a variable portion (col. 4, line 15 – col. 5, line 44).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Paris; system to provide for the following: mediator server



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generates a message with a blank period, with the blank period being filled in with content designated by the user of the first telephone, mediator server generates a message having a standard portion and a blank period and wherein the mediator server fills in the blank period with variable content, generating a message having a fixed portion and a variable portion as this arrangement would facilitate to customize messages to suite users needs as taught by Pinter.

10. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paris in view of Pinter as applied to claim 6 above, and further in view of Higuchi et al. (EP 0851647, hereinafter Higuchi).

The combination differs from claims 13-14 in that it does not specifically teach the following: telephone is a cellular telephone, cellular network providing cellular telephone service.

However, Higuchi discloses cellular mobile telephone apparatus and method for transmitting a response message to an incoming call which teaches the following: telephone is a cellular telephone (figs. 1-2), cellular network (not shown) providing cellular telephone service (col. 8 lines 23-41).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: telephone is a cellular telephone, cellular network providing cellular telephone service as this arrangement would facilitate the user to use cellular phone and handle telephone calling during driving etc, as taught by Higuchi, thus enhancing user convenience.

11. Claims 15, 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paris in view of Pinter as applied to claims 6, 16 above, and further in view of Jones et al. (US PAT: 6,141,341, hereinafter Jones).

The combination differs from claims 15, 26-27 in that it does not teach the following: first telephone establishes conversations using a VOIP protocol, establishing conversation between telephones using an internet communication device.

However, Jones discloses voice over internet protocol telephone system and method which teaches the following: first telephone establishes conversations using a VOIP protocol, establishing conversation between telephones using an internet communication device (col. 1, line 64 – col. 2, line 16).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: first telephone establishes conversations using a VOIP protocol, establishing conversation between telephones using an internet communication device as this arrangement would facilitate the user to make of VOIP telephone services which provide an economical method of communicating between users as is well known in the art.

12. Claims 19, 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paris in view of Pinter as applied to claims 16 above, and further in view of Fostick (US 2002/0159572A1).

The combination differs from claim 19, 22-23 in that it does not teach the following: receiving a voice signal from one of the telephones and processing the voice signal to generate the message, voice signal is generated from one of the telephones

and an alphanumeric message is generated from the voice message, text signal is generated from one of the telephones and corresponding voice message is generated.

However, Fostick discloses non voice completion of voice calls which teaches the following: converting the voice message to different formats such as email, fax etc suitable for delivery to different terminals (fig. 3, abstract; paragraph: 0066).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: receiving a voice signal from one of the telephones and processing the voice signal to generate the message, voice signal is generated from one of the telephones and an alphanumeric message is generated from the voice message, text signal is generated from one of the telephones and corresponding voice message is generated as this arrangement would facilitate to convert the message to be delivered to a suitable format so that it can be delivered to different communication terminals to suite user needs as taught by Fostick, thus facilitating user convenience.

13. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paris in view of Pinter and Fostick as applied to claim 19 above, and further in view of Kasvand et al. (US PAT: 2003/0163300A1, hereinafter Kasvand).

The combination differs from claim 20 in that it does not specifically teach the following: processing includes translating the voice signal into a message in a different language.

However, Kasvand discloses system and method for message language translation which teaches the following: processing includes translating the voice signal into a message in a different language (abstract; paragraphs: 0007-0008; fig. 7).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Paris' system to provide for the following: processing includes translating the voice signal into a message in a different language as this arrangement would facilitate communications in the context of increasing globalization of business as taught by Kasvand (paragraph:0002).

14. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paris in view of Pinter as applied to claim 21 above, and further in view of Kasvand.

The combination differs from claim 24 in that it does not teach the following: voice signal is generated in a first language and voice message is translated in a different language.

However, Kasvand teaches the following: voice signal is generated in a first language and voice message is translated in a different language (abstract; paragraphs: 0007-0008; fig. 7).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: voice signal is generated in a first language and voice message is translated in a different language as this arrangement would facilitate communications in the context of increasing globalization of business as taught by Kasvand (paragraph:0002).

15. Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paris in view of Pinter as applied to claims 1, 6, 16 above, and further in view of Schuster et al. (US PAT: 6,937,699, filed 9-27-1999, hereinafter Schuster).

The combination differs from claims 31-33 in that it does not teach the following: mediator server sends the message to the first telephone; mediator server sends the message to the second telephone; message sent to both telephones.

However, Schuster system and method for advertising using data network telephone connections which teaches the following: mediator server (reads on commercial message server) sends the message to the first telephone; mediator server sends the message to the second telephone; message sent to both telephones (abstract; fig. 7, col. 22 lines 29-46).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: mediator server sends the message to the first telephone; mediator server sends the message to the second telephone; message sent to both telephones as this arrangement would facilitate for users to receive interesting information about products and services as taught by Schuster so that users make use of the information to meet their needs.

### ***Response to Arguments***

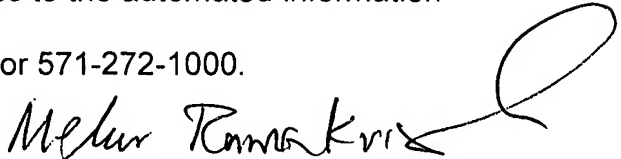
16. Applicant's arguments with respect to claims 1, 3, 5-29, 31-34 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Melur Ramakrishnaiah  
Primary Examiner  
Art Unit 2614